

30 AUG 2010



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

29052
SUTHERLAND ASBILL & BRENNAN LLP
999 Peachtree Street, N.E.
Atlanta, GA 30309

In re Application of
WERNER *et al*
U.S. Application No.: 10/585,215
PCT No.: PCT/DE2005/000372
Int. Filing Date: 03 March 2005
Priority Date: 03 March 2004
Attorney Docket No.: 071956.0113
For: USE OF A METAL COMPLEX AS AN
N-DOPANT FOR AN ORGANIC
SEMICONDUCTING MATRIX
MATERIAL, ORGANIC OF
SEMICONDUCTING MATERIAL AND
ELECTRONIC COMPONENT, AND
ALSO A DOPANT AND LIGAND AND
PROCESS FOR PRODUCING SAME

DECISION

This decision is in response to applicants' petition under 37 CFR 1.47(a) filed in the United States Designated/Elected Office (DO/EO/US) on 24 February 2009.

BACKGROUND

On 18 August 2008, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 24 February 2009, applicants filed a response which was accompanied by, *inter alia*, the subject petition; a declaration signed by seven of the eight named inventors; a \$200.00 petition fee; a five-month extension fee of \$2,350.00; a \$130.00 surcharge fee; and Exhibits 1 - 2.

On 19 May 2009, the DO/EO/US mailed a Notification of Acceptance of Application Under 35 U.S.C. 371 and 1.495 (Form PCT/DO/EO/903) and filing receipt indicating that the "Date of Receipt of 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) Requirements," the "Date of Completion of all 35 U.S.C. 371 Requirements" and the "Filing or 371(c) Date" is 24 February 2009.

DISCUSSION

Applicants claim that one of the eight-named inventors (Olaf KÜHL) refuses to cooperate and filed a petition under 37 CFR 1.47(a) in response to the Form PCT/DO/EO/905.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventors on their behalf and on behalf of the nonsigning joint inventor.

Applicants completed items (1) and (3) with the subject petition.¹

Regarding item (2), applicants claim that the nonsigning inventor's conduct constitutes a refusal to cooperate. Applicants included a letter dated 20 February 2009 from Volker Scholz, a European patent attorney. Mr. Scholz states that he twice sent the declaration to Mr. KÜHL by certified mail to the inventor's address. However, the inventor did not open the door to retrieve the letter. Mr. Scholz claims that the postal service then informed Mr. KÜHL to "fetch the letter," but that Mr. KÜHL did not appear at the post office to take the letter. A copy of several postal receipts in a foreign language were submitted with the petition and labeled as Exhibit 2.

This evidence is insufficient to satisfy MPEP 409.03(d)(II).

It is true that petitioners may show a refusal to cooperate by submitting sufficient proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent. However, petitioners have not made such a showing here.

First, the Office does not accept documents in a foreign language as evidence without an accompanying English translation. The postal receipts (Exhibit 2) submitted with the petition require an English translation to be considered. Second, copies of the cover letters purportedly sent to the nonsigning inventor should be provided. Finally, MPEP § 409.03(d) II requires that a complete copy of the application be presented (or attempted to be presented) to the nonsigning inventor for a refusal to cooperate be

¹ The \$200.00 fee for a petition under 37 CFR 1.47 has been paid. The last known address of the nonsigning inventor was provided in the petition.

accepted. Here, the letter by Mr. Scholz dated 20 February 2009 indicates that only a Declaration was provided to the nonsigning inventor.

For these reasons, item (2) of 37 CFR 1.47(a) is not satisfied.

Concerning item (4), the 37 CFR 1.47(a) applicants submitted a declaration signed by seven joint inventors on behalf of the nonsigning joint inventor. A review of the declaration shows that the address of joint inventor, Kentaro HARADA has been altered and the change was not initialed.

Any changes made in ink should be initialed and dated by the applicants prior to execution of the declaration. The Office will require a new oath or declaration if the alterations are not initialed and dated. See MPEP § 605.04(a). A new declaration for Mr. HARADA is required.

For these reasons, item (4) of 37 CFR 1.47(a) is also not yet satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extension of time under 37 CFR 1.136(a) is available.

The Form PCT/DO/EO/903 and filing receipt mailed 19 May 2009 are hereby **VACATED**.

Any further correspondence with respect to this matter may be filed electronically via EFS-Web selecting the document description "Petition for review and processing by the PCT Legal Office" or by mail addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302